PATENT
CUSTOMER NUMBER, 34,986
Docket No. 01064.0011-05000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	
Richard LEVY	Group Art Unit: 1714
Serial No.: 09/359,809	Examiner: Cephia Toomer
Filed: July 21, 1999	
For: LUBRICANT COMPOSITIONS AND METHODS	

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

APPELLANT'S BRIEF ON APPEAL PURSUANT TO 37 C.F.R. § 41.37 (AMENDED)

The examiner, rather than timely submitting a response to Appellant's July 31, 2006 Appeal Brief (refilled on August 28, 2006 with proof of filing on July 31) delayed responding by 12 months and in stead filed a July 11, 2007 office Communication based on an incredibly delayed argument that the Brief did not indicate where the written description supported the elements of the claims and did not include the required appendices. Appellant will address this in the sections that follow, and otherwise submits this brief to set forth the authorities and arguments on which appellant will rely to maintain the appeal.

Appellant paid the $160.00 fee (small entity) required by 37 C.F.R. § 41.20(b) (2), at the time of filing the August 12, 2002 brief in this application. The Manual of Patent Examining Procedure (M.P.E.P.) §1204.01 waives $160.00 of the $250.00 fee due for filing the July 31, 2006 brief, so appellant included payment of the $90.00 difference with the filing of that brief.

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(I) **Real Party in Interest**

The inventor assigned the parent application Serial No. 08/487,436, filed June 7, 1995 to Lee County Mosquito Control District. The assignment was recorded at reel 7878, frame 0820 on August 23, 1995, which makes Lee County Mosquito Control District the real party in interest.

(ii) **Related Appeals and Interferences**

Appellant has the following co-pending appeals before the Board of Patent Appeals and Interferences in related applications:

Serial No. 08/943,125 Filed October 3, 1997 (Attorney Docket 01064.0011-02-000)

Serial No. 10/614,114 Filed July 7, 2003 (Attorney Docket 01064.0011-08-0000)

Serial No. 09/357,957 Filed July 23, 1999 (Attorney Docket 01064.0011-04-0000)

The Board of Patent Appeals and Interferences rendered a decision in an appeal on application Serial No. 08/943,125 Filed October 3, 1997 on February 27, 2006, reversing the examiner in all respects, but remanding the application to the examiner for further action. The Patent Office, however, labeled the file jacket of that application as follows:

U. S. PATENT AND TRADEMARK OFFICE
RETURN TO (PTO 1056)
INTERFERENCE SERVICE BRANCH
This case is involved in an
Interference Proceeding

Appellant includes in section "(x) Related proceedings appendix" of this brief the Board's February 27, 2006 decision in application Serial No. 08/943,125 and a certified copy of the file jacket of that application showing the foregoing label regarding the interference. Appellant also included that label as an attachment to appellant's brief in Serial No. 08/943,125. The Patent and Trademark Office has not notified appellant that they have declared an interference in any of the foregoing applications, even though they indicated on the file of application Serial No. 08/943,125 "[t] his case is involved in an Interference Proceeding." The Board also advised,

when contacted by appellant's attorneys by telephone, that the Patent Office had not declared an interference in application Serial No. 08/943,125. Lastly, the Board's decision in the pending appeal could directly affect, or be directly affected by, or having a bearing on the decision in the co-pending appeals. Appellant attaches a copy of

Appellant calls the Board's attention to the United States Patent Application of Martin C. Flautt et al., Serial No. 09/190,866 filed November 13, 1998. Appellant advised the examiner that appellant's Application Serial No. 09/779,588 copies claims from the corresponding Flautt et al. PCT Application WO 00/29486. The Patent and Trademark Office, as of the filing of this brief, has not declared an interference between appellant's Application Serial No. 09/779,588. and Flautt et al., Serial No. 09/190,866.

(iii) **Status of Claims**

As of August 31, 2005 appellant had cancelled claims 1-72 without prejudice or disclaimer, leaving claims 73 - 100 in the application.

(iv) **Status of Amendments**

The examiner has entered appellant's August 31, 2005 amendment to claims 73, 76, 77, 80-83, and 90.

(v) **Summary of Claimed Subject Matter**

Concise explanation of the subject matter defined in each of the independent claims involved in the appeal with reference to the page number and line or paragraph numbers of the written description.

Independent claim 73 relates to an aspect of the invention comprising a process for manufacturing a lubricant composition comprising a polymer where the polymer comprises a superabsorbent polymer that absorbs more than about 100 times its weight in water described inter alia in the paragraph bridging pages 20-21 through page 25, line 2. The process involves

combining the polymer with a material for lubricating a surface where the material for lubricating a surface comprises:

(1) a lubricating metal described inter alia on page 15, paragraph 2, 17, paragraph 3, and page 27, lines 11-13; alloys thereof described inter alia on page 27, line 11; a lubricating metal chalcogen compound described inter alia on page 17, lines 8-9 from the bottom, page 27, lines 3-6; halide described inter alia on page 27, lines 8, 9; carbonate described inter alia on page 27, lines 9-10; silicate described inter alia on page 10,line 11, page 13, first full paragraph; or phosphate described inter alia on page 27, lines 17-18; or a particulate lubricating metal nitride described inter alia on page 27, line 8; or a carbon lubricant described inter alia on page 4, line 10, page 13, line 5 from the bottom of the page, page 14, line 13, page 40 lines 9-10 from the bottom of the page; or

(2) a silicate ester described inter alia on page 13, first full paragraph; polyphenyl ether described inter alia on page 10, line 11; organic phosphate described inter alia on page 8, lines 5-6 from the bottom, page 10, line 10; chlorinated biphenyl page 12, line 11; phenanthrene described inter alia on page 17, line 7, page 27, line 2 from the bottom; or a phthalocyanine compound described inter alia on page 13, last line page 14, line 5 from the bottom, page 17,lines7-10;

(3) where the material for lubricating a surface optionally contains a lubricant comprising an, organic lubricant described inter alia on page 17, paragraph 2. page 22, first full paragraph, the paragraph bridging pages 27-28, the paragraph bridging pages 28-29, inorganic lubricant described inter alia in the paragraph bridging pages 15-16 to paragraph 1 on page 17, or lubricant additive described inter alia on pages 7-10;

(4) or mixtures thereof described inter alia in the paragraph bridging pages 23-24 through line 2 of page 25, page 26, first full paragraph, page 26 second full paragraph, page 28, first full paragraph to page29, first full paragraph.

Independent claim 74 relates to that aspect of the invention comprising a lubricant composition of matter comprising a product produced by the process of claim 73. This brief gives the claim 73 references to the page number and line or paragraph numbers of the written description.

Independent claim 76 relates to that aspect of the invention which is a lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where the polymer comprises a superabsorbent polymer, the mixture further comprising a material for lubricating a surface, wherein the superabsorbent polymer absorbs more than about 100 times its weight in water and wherein the material for lubricating a surface comprises a solid lubricant comprising a metal alloy, an inorganic chalcogen compound, halide, nitride, carbonate, phosphate compound, carbon lubricant, or metal material that provides barrier-layer lubrication, or mixtures thereof, and wherein the composition optionally comprises a lubricant additive. The written description describes this product by process aspect of the invention inter alia in the paragraph bridging pages 20-21. Claim 73 includes all of the elements of claim 76, and this brief recites the claim 73 references to the page number and line or paragraph numbers of the written description that support these elements.

Independent claim 80 relates to that aspect of the invention which is a lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where the polymer comprises a superabsorbent polymer, wherein the superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, the mixture further comprising a material for lubricating a surface, wherein the superabsorbent polymer absorbs more than about 100 times its weight in water, and wherein the material for lubricating a surface comprises water containing a lubricant

additive. The foregoing discussion of claim 73 in this brief indicates where the written description supports all of the claim 80 elements but for the element comprising water containing a lubricant. The written description supports this inter alia at page 25, lines 17-19.

Independent Claim 81 relates to that aspect of the invention which is a lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a superabsorbent polymer, wherein the superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, the mixture further comprising a material for lubricating a surface, wherein the superabsorbent polymer absorbs more than about 100 times its weight in water, and wherein the material for lubricating a surface comprises an oil or greases thereof and water, and wherein the composition optionally comprises a lubricant additive. The foregoing discussion of claim 73 in this brief indicates where the written description supports all of the claim 81 elements but for the element comprising an oil or greases thereof and water. The written description supports this inter alia at page 26, paragraph 4, page 25, line 19, page 26, line 2, and page 28, first full paragraph, and page 29, lines 11-20.

Independent Claim 82 relates to that aspect of the invention which is a lubricant composition of matter comprising a lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where the polymer comprises a superabsorbent polymer, wherein the superabsorbent polymer comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, the mixture further comprising a material for lubricating a surface, wherein the superabsorbent polymer absorbs more than about 100 times its weight in water, wherein the material for lubricating a surface comprises a solid lubricant and water, and wherein the

composition optionally comprises a lubricant additive. The foregoing discussion of claim 81 in this brief indicates where the written description supports all of the claim 82 elements.

Independent Claim 84 relates to that aspect of the invention which is a lubricant composition of matter comprising a product produced by the process comprising forming a mixture comprising a polymer where the polymer comprises a superabsorbent polymer, the mixture further comprising a material for lubricating a surface, wherein the superabsorbent polymer absorbs more than about 100 times its weight in water, wherein the material for lubricating a surface comprises a phosphate, and wherein the composition optionally comprises a lubricant additive. The foregoing discussion of claim 73 in this brief indicates where the written description supports all of the claim 84 elements.

Dependent claim 89 relates to that aspect of the invention comprising a substantially anhydrous composition. Pages 31-32 and Example I inter alia on pages 33-34 of the written description support the substantially anhydrous parameter.

(vi) Grounds of Rejection to be Reviewed on Appeal

a. Whether the judicially created doctrine of obviousness-type double patenting applies to claims 73 -100 taken in view of claims 57-90 of copending application Serial No. 10/614,114 filed July 7, 2003 and claims 90 -115 of copending application Serial No. 10/763,687 filed January 24, 2004.

b. Whether the examiner has properly applied 35 U.S.C. 112, first paragraph in rejecting claim 89 relating to a substantially anhydrous composition.

c. Whether Takayama, United States Patent No. 5,792,717 supports the examiner's rejection of claims 73, 74, 76, 77 and 90 under 35 U.S.C. § 103(a);

d. Whether Johnson, United States Patent No. 5, 275,760 in view of Obayashi et al. United States Patent No. 4,340,706 ("Obayashi") support the examiner's rejection of claims 73-76, 80-82, 86, 87, 89-93, 96, 99, and 100 under 35 U. S. C. § 103 (a);

(vii) Argument

The Provisional Double Patenting Rejection

The examiner provisionally rejects claims 73-100 under the judicially created doctrine of obviousness-type double patenting based on copending applications Serial No. 10/614,114 filed July 7, 2003 and Serial No. 10/763,687 filed January 24, 2004. Appellant traverses the rejection since neither copending application has issued as a patent, and further requests allowance if neither of the copending applications issues, and the only rejection remaining in the present application consists of the provisional obviousness-type double patenting rejection. If one of the co-pending applications issues as a patent, appellant reserves the right to distinguish the claims in this application from the claims of the copending application or applications in the event this application still remains as a pending application at the time of issue of one of the other applications.

Appellant should not be required to file a terminal disclaimer in the present application since the Patent Office may not allow the copending applications (Serial No. 10/614,114 filed July 7, 2003 and Serial No. 10/763,687 filed January 24, 2004) which form the basis of the double patenting rejection. When a provisional double patenting rejection is the sole remaining rejection in an earlier filed application, (the present application, Serial No. 09/359,809, filed July 21, 1999) and the present application is otherwise in condition for allowance, the M.P.E.P. states that the examiner should withdraw the rejection in the application and permit it to issue as a patent. M.P.E.P. § 804(I) (B).